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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,976	05/16/2005	Soichiro Watanabe	272239US0PCT	1724
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MERCIER, MELISSA'S	
			ART UNIT	PAPER NUMBER
			1615	
			NOTIFICATION DATE	DELIVERY MODE
			05/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No. 10/534,976	Applicant(s) WATANABE, SOICHIRO	
	Examiner Melissa S. Mercier	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Summary**

Receipt of Applicants Remarks and Amended Claims filed on January 29, 2007 is acknowledged. Claims 11-16 are newly added, therefore, claim 1-16 are pending in this application.

In view of Applicants Amended Claims and arguments, all rejections in the previous Office Action dated November 3, 2006 have been withdrawn. This office action contains the complete set of rejections pending in this application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

M.P.E.P. § 2163 states, "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention...one must define a compound by 'whatever characteristics sufficiently

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distinguish it'. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."

While the specification describes a species of the instantly claimed ascorbic acid derivatives and glycyrrhizic acid derivatives at p. 8-9, it does not describe a sufficient number of species as to convey possession of the entire genus encompassed by the generic term.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-7, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. (US Patent 5,733,344) in view of Leverett (US Patent 6,132,739).

Shiraishi discloses a temporary hair dye containing titanium black and other pigments (abstract). Titanium-titanium dioxide sintered substance is disclosed as titanium black (column 2, lines 9-10). The titanium black is present in the amount of 0.5 to 5 parts by weight in examples 4-5 and comparative examples 1 and 5. Water is disclosed as the principle solvent (column 3, lines 36-38). Additionally, resins, surfactants, perfumes, oil & fats, scarcely volatile hydrocarbons, silicone oils, and water can be added (column 4, lines 10-12).

Shiraishi does not disclose the use of polyvinyl alcohol, anionic surfactants, or water-soluble thickeners.

Leverett discloses, a "makeup compositions having enhanced transfer resistance including at least one hydrophilic film former. The makeup can be a water-in-oil emulsion having the hydrophilic film former in the internal water phase and at least one pigment in the external oil phase. The makeup composition can also be a suspension of one or more pigments in water in which the hydrophilic film former is dissolved. The

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hydrophilic film former may also be an anionic gelling agent, whereby the cationically-coated pigment and the anionic gelling agent form a water-dispersible complex that upon application to the skin forms an insoluble pigmented salt having enhanced transfer resistance”(abstract).

Leverett further teaches, “the water phase comprises a hydrophilic film former, polyvinyl alcohol” (column 4, lines 44-48). Effective amounts of the hydrophilic film former are from 0.1 to about 8%. (column 5, lines 10-16).

Regarding the specific conditions of preparation of the sinter, it is the examiners position that Shiraishi discloses the use of Tilack D, which applicant’s specification on page 6, top paragraph, recites as an acceptable sinter.

The recitation of a peel-off cosmetic pack preparation in claim 15 is considered future intended use of the composition and therefore, not given patentable weight.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the particles size of the titanium-titanium dioxide sinter in order to obtain the desired color intensity, the ratio of titanium to titanium dioxide, and the mixture of polyvinyl alcohol, in order to obtain a cosmetic composition with the desired consistency and properties, because the determination of a specific percentage/ratios having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of

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the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the hydrophilic film former polyvinyl alcohol with the pigmented titanium-titanium dioxide sinter since it has a strong coloring power and Shiraishi discloses the use of a resin system, therefore, It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of film forming resins. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Claims 2-5, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. (US Patent 5,733,344) in view of Leverett (US Patent 6,132,739) and further in view of Cowsar et al. (US Patent 5,565,216).

The combined teachings of Shiraishi and Leverett are discussed above and applied in the same manner.

Shiraishi and Leverett do not disclose the use of an anionic surfactant, a water-swelling clay mineral or amorphous silicic anhydride and ascorbic acid derivative or a glycyrrhizic acid derivative.

Cowsar discloses a hair relaxer composition comprising a surfactant. Dioctyl sodium sulfosuccinate is disclosed (column 8, lines 30-33). A thickener including hydrated magnesium aluminum silicate, anhydrous aluminum silicate and colloidal clay are disclosed (column 10, lines 38-45). Example 6 discloses the use of ascorbic acid.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach polymers, solvents, surfactants, antioxidants and free radical scavengers, are effective ingredients in cosmetic compositions, it would have been obvious to combine these plants with the expectation that such a combination would be effective in cosmetic compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. (US Patent 5,733,344) in view of Leverett (US Patent 6,132,739) and further in view of Guerrero (US Patent 5,609,854).



The combined teachings of Shiraishi and Leverett are discussed above and applied in the same manner.

Shiraishi and Leverett do not disclose the use of a polyglycerol fatty acid ester.

Guerrero teaches a thickened and stabilized cosmetic emulsion composition.

Guerrero's composition comprises polyglycerol fatty acid esters as emollients. (column 2, lines 62-65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Leverett with the thickeners and stabilizers of Guerrero in order to achieve an aesthetically pleasing viscosity. Guerrero discloses "fluids that flow with a watery consistency too rapidly run off the treated skin areas. For cosmetics to be effective, it often must have substantively" (column 1, lines 12-20).

The applicants would have a reasonable expectation that the new composition would function as a cosmetic composition, since both references teach a cosmetic composition.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

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### **Conclusion**


No claims are allowable. **Due to the new grounds of rejection, this action is made Non-Final.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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